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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,233	02/14/2001	Shozo Nagano	30-5000-4015-Div2	3214

7590 06/19/2003

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

21

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,233

Applicant(s)

NAGANO ET AL.

Examiner

Sikyln Ip

Art Unit

1742

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-77,81,82,84,85 and 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-77,81,82,84,85 and 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 65-72, 74-77, 81, 82, 84-85, and 88 are rejected under 35 U.S.C. 103(a) as obvious over JP 10287939 (abstract) or USP 6113761 to Kardokus et al (PTO-1449, claims 1-9).

4. Claim 73 is rejected under 35 U.S.C. 103(a) as obvious over Reda (PTO-1449).

5. The cited reference(s) disclose(s) the features including the claimed Cu alloy composition and grain size. The difference between the reference(s) and the claims

are as follows: cited references do not disclose the claimed resistivity. However, the instant composition and grain size are overlapped by the cited references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

6. It is well settled that a newly discovered property does not necessarily mean the product is unobvious, since the property is inherently possessed in the prior art. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), In re Swinehart, 169 USPQ 226 (CCPA 1971), In re Skoner, et al., 186 USPQ 80, and MPEP § 2112.01. Similar process can reasonably be expected to yield products which inherently possess the same properties. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re DeBlauwe, 222 USPQ 191, and In re Wiegand, 86 USPQ 155 (CCPA 1950). A newly discovered property does not necessarily mean the product and/or process is unobvious, since this property would have been inherently possessed by the prior art. In re Best, 195 USPQ 430, 433 and In re Swinehart, 169 USPQ 226.

In re Best, 195 USPQ, 430 and MPEP §2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).”

Therefore, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the subject matter disclosed by the reference. Overlapping ranges have been held to be a prima facie case of obviousness.

7. An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. *In re Gyurik*, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See *In re May*, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and *In re Hoch*, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970).

Response to Arguments

8. Applicant's arguments filed April 3, 2003 have been fully considered but they are not

persuasive.

9. Applicants argue that alloys of cited references contain many additional elements. But, it is well settled that the recitation of “consisting essentially of” limits the scope of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition. *Ex parte Davis*, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948), *In re Janakirama-Rao*, 317 F. 2d 951, 137 USPQ 893, 894 (CCPA 1963), *In re Garner*, 412 F 2d 276, 162 USPQ 221, 223 (CCPA 1969), and *In re Herz*, et al., 190 USPQ 461, 463 (CCPA 1976). When applicant contends that modifying components in the reference composition are excluded by the recitation of “consisting essentially of” applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. *In re De Lajarte*, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and *Ex parte Davis*, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).
10. Applicants argue that alloy of Eguchi is not a physical vapor deposition target. But Eguchi suggests the copper alloy could be used for heat medium such as contacts which reads on physical vapor deposition target.

Conclusion

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
June 14, 2003